



03-07-05

1652/4#

PATENT

1fw

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 97,022-K2)

In re Application of:

Giuliano, et al.

Serial No.: 09/713,572

Filed: November 15, 2000

For: A System for Cell-Based Screening

Art Unit: 1652

Examiner: Wallicka, M.

Conf. No. 5670

Mail Stop: RESPONSE
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO THE
OFFICE ACTION DATED SEPTEMBER 27, 2004**

Dear Sir,

Please consider the following amendments and remarks in response to the Office Action mailed September 27, 2004:

The Applicants herewith elect the Invention of Group I for continued prosecution in the present case. The election is made with traverse, as the search required for Group I is also required for Groups II and III. Thus, there is no additional hardship on the Patent Office is carrying out the search for all of the listed Inventive Groups. The Applicants further note the presently pending claims were restricted out as a single inventive group in the parent case to which this application claims priority. Finally, the Applicants note that this application was filed in November of 2000, and thus it has taken the Patent Office almost four years to make the present restriction requirement. The Applicants submit that it would be an undue hardship to require that two further applications be filed in order to pursue the claims of the invention, particularly where the Patent Office previously found that the subject matter was a single inventive group in the parent case, the subject matter overlaps so extensively, and pursuing the other sets of claims may require another 4 years of pendency before prosecution on the merits begins. Thus, the Applicants respectfully request reconsideration and withdrawal of this restriction requirement.

The Applicants further elect the following species for prosecution on the merits to which

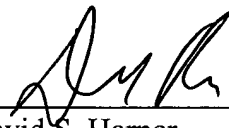
the claims shall be restricted if no generic claim is finally held to be allowable:

- a) a first domain comprising at least one detectable polypeptide signal: SEQ ID NO:43
- b) a second domain comprising at least protease recognition site: SEQ ID NO:117
- c) a third domain comprising at least one reactant target sequence: SEQ ID NO:149

If there are any questions or comments regarding this response, the Examiner is encouraged to contact the undersigned agent as indicated below.

Respectfully submitted,

Date: 3/3/05



David S. Harper
Registration No. 42,636

Telephone: 312-913-0001
Facsimile: 312-913-0002

**McDonnell Boehnen
Hulbert & Berghoff, Ltd.**
300 South Wacker Drive
Chicago, IL 60606